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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,630	11/12/2003	Marguerite B. McDonald	55915-79433	7979
44777	7590	03/17/2006	EXAMINER	
W. EDWARD RAMAGE COMMERCE CENTER SUITE 1000 211 COMMERCE ST NASHVILLE, TN 37201			PREBILIC, PAUL B	
			ART UNIT	PAPER NUMBER
			3738	
DATE MAILED: 03/17/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/706,630

Applicant(s)

MCDONALD, MARGUERITE B.

Examiner

Paul B. Prebilic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25, 27-35 and 37-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-24, 27-35, 37, 38, 44 and 45 is/are allowed.
- 6) ☒ Claim(s) 1-11 and 39-43 is/are rejected.
- 7) ☒ Claim(s) 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/10/06
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

***Claim Objections***

Claim 25 is objected to because of the following informalities:

On line 2 of claim 25, it appears that the word "are" could be --is-- to be less grammatically awkward. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by McClure (US 4,512,040). McClure anticipates the claim language where the lens body as claimed is lens (10) of McClure, the substantially elliptical anterior surface as claimed is the inner anterior surface (36), and the substantially elliptical posterior surface is the inner posterior surface (38) along with the inner posterior surface of chamber (20); see Figures 1 to 4 as column 2, line 64 to column 4, line 4. Substantially elliptical is interpreted to encompass spherical surfaces because "substantially" is a broad term; see MPEP 2173.05(b)(D) that is incorporated herein by reference.

With regard to claims 2 and 3, the curve of the upper periphery (see Figure 2) is the second smaller radius of curvature as well as the curves shown on the anterior surface of Figure 2.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClure (US 4,512,040) alone. McClure meets the claim language but fails to clearly teach making the lens (10) out of synthetic material. However, in the background of McClure, it is taught that it was known to make prior art lenses out of synthetic materials such as polymethylmethacrylate; see column 1, lines 11-16. Therefore, it is the Examiner's position that it would have been obvious to make the McClure lens (10) out of polymethylmethacrylate since that was a well known accepted material at the time McClure's invention was made and for the same reasons that the prior art used the same.

Claims 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClure (US 4,512,040) in view of Holmen (US 6,986,763). McClure meets the claim language as explained in the Section 102 rejection supra but fails to disclose a substance for dispersion with an enucleated eye as claimed. However, Holmen teaches that it was known to use a colored viscoelastic solution material to fill eyes enucleated during cataract surgery; see column 11, lines 3-39. Therefore, it is the Examiner's position that it would have been obvious to use the viscoelastic solution (a liquid or gel)

along with the lens of McClure for the same reasons that Holmen teaches using the same; see the previously cited portion.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over McClure (US 4,512,040) in view of Grendahl (US 4,778,462). McClure meets the claim language as explained in the Section 102 rejection *supra*, but fails to disclose a colored or "not colorless" lens as claimed. However, Grendahl teaches that it was known to color different parts of intraocular lenses with different colors for enhanced accommodation; see column 2, lines 15-19. Therefore, it is the Examiner's position that it would have been obvious to color the different portions of the McClure lens system for the same reason that Grendahl does the same.

#### ***Allowable Subject Matter***

Claims 12-24, 27-35, 37, 38, 44, and 45 are allowed over the prior art of record.

Claim 25 is objected to only, but would be allowable if rewritten to eliminate the objected to language.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic  
Primary Examiner  
Art Unit 3738